



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/873,331	06/05/2001	Uzi Gati	10236-0027	4162

20582 7590 04/04/2003

PENNIE & EDMONDS LLP
1667 K STREET NW
SUITE 1000
WASHINGTON, DC 20006

EXAMINER

ACKUN, JACOB K

ART UNIT

PAPER NUMBER

3712

DATE MAILED: 04/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/873,331

Applicant(s)

GATI, UZI

Examiner

Jacob K. Ackun Jr.

Art Unit

3712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 January 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-7 and 9-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-7 and 9-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. Claims 2-7 and 9-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lindsay. Lindsay discloses most of the elements of the claims but for features such as the protrusion being on the insert and the corresponding recess being on the insert holder (Lindsay shows the reverse). Lindsay also does not teach the recess extending in a longitudinal direction and the clamping abutment surfaces of the insert being sloped. On the other hand it would have been obvious to provide the invention of Lindsay with the missing features for the purpose of more securely retaining the insert, to allow for easier insertion and removal of the insert, for design or aesthetic reasons, or depending on the particular application/insert desired. Reversing the surfaces on which a protrusion and recess are placed would not appear to be novel or unobvious, for example.
3. Applicant's arguments filed on 01/21/03 have been fully considered but they are not persuasive. First, the examiner incorporates herein the specific comments made in the last Office Action in response to the argument filed by the applicant on 07/30/02 (See Paper No. 6 at paragraph 3 thereof). Second, the additional arguments made by the applicant in the response filed on 1/21/03 are responded to as follows.

The applicant argues that reversing Lindsay's keyway and pin would not make sense to one having ordinary skill in the art because it would result in a cutting insert that was more costly to manufacture and more cumbersome to use. In support of this argument the applicant indicates that the proposed modification to Lindsay would require one to form a transversely extending hole in the cutting insert 32 and to insert a pin into the newly formed hole. These arguments are

Art Unit: 3712

unconvincing because the applicant has provided no support for the assertion that the proposed modification would be more costly in terms of the cost of the insert. Similarly, the Declaration pointed to by the applicant merely asserts that there would be greater cost without explaining precisely why. Moreover, it would appear that even if the modified insert were shown to be more costly, any increased cost would be offset by a decreased cost for holder 12, since the hole and pin would not be made therein. Additionally, the argument that the proposed modification to Lindsay would require forming a hole in cutting insert 32, etc., is another assumption made by the applicant that is unsupported by fact. It is believed that one having ordinary skill in the relevant art is quite capable of forming a pin or protrusion by methods other than that shown for the holder 12 of Lindsay. The rejection for obviousness only indicates that the insert can have the pin, and correspondingly, the appropriate surface of the holder have the keyway. Under relevant law the artisan does not have to blindly follow every teaching in the base reference in order to make a specific modification to the reference.

The applicant also argues that Lindsay teaches away from permitting longitudinal movement of the insert relative to the insert holder. However, this argument is made by the applicant in support of the traversal of the rejection of claims 9, 19, 23, 27 and 31, claims that the applicant characterizes as clearly reciting structure that permits sliding insertion of a cutting insert into a cutting insert holder along a longitudinal direction of the cutting insert. This second argument of the applicant is also unconvincing for the following reasons. The portions of Lindsay pointed to by the applicant do teach that Lindsay does not want the cutting insert to move longitudinally, but only in the sense that movement not occur during use of the tool. This is a far cry from teaching away from a specific direction of insertion of the insert into the tool.

Art Unit: 3712

While the insert of Lindsay is inserted vertically into the tool because of the configuration disclosed, no portion of the Lindsay document requires insertion of an insert only in this fashion, as the applicant appears to suggest. Thus the examiner disagrees that the portions of Lindsay pointed to by applicant teach away from longitudinal insertion, merely because they teach away from longitudinal movement in use. It is noted that even the instant application does not teach longitudinal movement of the insert holder during use of the tool. On the contrary, the insert holder is securely clamped as is conventional, after its insertion longitudinally into the tool.

As to the Declaration submitted under Rule 132 most, if not all of the assertions therein are unsupported by appropriate documentation or other proof. Thus any showing of unobviousness by the Declaration is outweighed by the indications of obviousness of record.

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

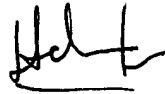
Art Unit: 3712

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jacob K. Ackun Jr. whose telephone number is (703)308-3867.

The examiner can normally be reached on Monday through Friday 8.30AM-5.00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached on (703)308-1745. The fax phone numbers for the organization where this application or proceeding is assigned are (703)305-3579 for regular communications and (703)305-3579 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0858.



Jacob K. Ackun Jr.
Primary Examiner
Art Unit 3712

J.A.
April 2, 2003